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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,676	12/26/2001	Crisanto Gutierrez-Armenta	4148-6	8375

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EXAMINER
MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
1638	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/025,676	GUTIERREZ-ARMENTA ET AL.
	Examiner Ashwin Mehta	Art Unit 1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 December 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) _____ is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____ .

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 and 18-21, drawn to a method of controlling the growth of a plant cell comprising increasing the level or activity of retinoblastoma protein by incorporation of a recombinant nucleic acid; a plant cell comprising a recombinant nucleic acid encoding for expression of a retinoblastoma protein; a transgenic plant comprising said cell, classified in class 435, subclass 468, for example.
- II. Claims 1, 2, and 4-6, drawn to a method of controlling the growth of a plant cell comprising decreasing the level or activity of retinoblastoma protein by incorporation of a recombinant nucleic acid; or said method wherein the nucleic acid is such as to inhibit expression of a retinoblastoma protein, classified in class 800, subclass 290, for example.
- III. Claims 1-3 and 18-21, drawn to a method of controlling the growth of a plant virus within a plant cell comprising increasing the level or activity of retinoblastoma protein by incorporation of a recombinant nucleic acid; a plant cell comprising a recombinant nucleic acid encoding for expression of a retinoblastoma protein; a transgenic plant comprising said cell, classified in class 800, subclass 279, for example.
- IV. Claims 1, 2, 4, and 5, drawn to a method of controlling the growth of a plant virus within a plant cell comprising decreasing the level or activity of retinoblastoma protein by incorporation of a recombinant nucleic acid; or said method wherein

the nucleic acid is such as to inhibit expression of a retinoblastoma protein, classified in class 800, subclass 286, for example.

- V. Claims 7-14 and 17, drawn to a recombinant nucleic acid encoding for expression of a retinoblastoma protein, classified in class 536, subclass 23.6, for example.
- VI. Claims 15 and 16, drawn to a protein, classified in class 530, subclass 350, for example.

Claims 1 and 2 link(s) inventions I-IV. Claims 1-3 and 18-21 link Groups I and III.

Claims 1, 2, 4, and 5 link Groups II and IV. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-5. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable.

In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-II and III-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The methods of Groups I and II affect the growth of a plant cell, whereas the methods of Groups III and IV affect the growth of a plant virus.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and effects. The method of Group I requires an increase in expression of a retinoblastoma protein, whereas the method of Group II decreases the expression or activity of a retinoblastoma protein. The opposite method steps will produce opposite effects on the growth of the plant cell. Processes that affect plant cell growth in different ways would not be found in the same search.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and effects. The method of Group II requires an increase in expression of a retinoblastoma protein, whereas the method of Group III decreases the expression or activity of a retinoblastoma protein. The opposite method steps will produce opposite effects on the growth of a plant virus within a plant cell. Processes that affect the growth of plant viruses in different way would not be found in the same search.

Inventions I-IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the recombinant nucleic acid of Group V can be used in a different process, such as in a hybridization method.

Inventions I-IV and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The methods of Groups I-IV do not require the protein of Group VI as a starting material. A search for the protein of Group VI may not reveal any information about the processes of Groups I-IV.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for each of Groups II-VI, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Contact Information

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 571-272-0804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

January 12, 2004



Ashwin D. Mehta, Ph.D.
Primary Examiner
Art Unit 1638